

AMENDMENT UNDER 37 C.F.R. § 1.116 AND REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Attorney Docket No.: Q93540

Application No.: 10/569,831

REMARKS

As a preliminary matter, *the Examiner is respectfully requested to return an initialed copy of the Form PTO/SB/08 filed with Applicants' Disclosure Statement of February 28, 2006.*

Although the Examiner returned the Form with the Office Action dated May 21, 2009, the Examiner did not initial the form to indicate that the listed documents have been considered and made of record.

Request for Withdrawal of Finality of Office Action

The Examiner states at page 5 of the Office Action that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL."

However, the § 112, first paragraph, rejection in paragraph 9 (rejection of "prodrug") of the Office Action is a new rejection which was not necessitated by Applicants' Amendment. Accordingly, the finality of the Office Action is premature. In a telephone conversation with the Examiner on March 25, 2010, the Examiner agreed that the finality of the Office Action was premature.

Response to Office Action of March 8, 2010

In the present Amendment, claims 1, 27, 37, 40 and 41 have been amended to delete the term "prodrug." In addition, claim 1 has been amended to recite that "ring B represents a dihydronaphthalene group, an indene group, or a 6,7-dihydro-5H-benzo[7]annulene group which may further have a substituent(s);" that "R¹ represents a substituent of ring A" and that "when X is -O- or -CH₂-O- and ring A is phenyl, m is an integer of 1 to 5." Claim 22 has been amended

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to recite that “ R^{S0} , R^{S1} , R^{S2} , R^{S3} , R^{S4} , R^{S5} and R^{S6} each independently represents a hydrogen atom, a halogen atom, or C1-4 alkyl which may be substituted with 1 to 3 halogen atom,” which definition is found, for example, in original claim 22 and was inadvertently deleted in the Amendment under 37 C.F.R. § 1.111 filed November 20, 2009. Claim 38 has been amended to recite that the compound which has an ability to bind to EDG-6 and may have an ability to bind to EDG-1 is the compound represented by formula (IA-2-1) according to claim 1 or a salt thereof. No new matter has been added, and entry of the Amendment is respectfully requested.

Claims 1, 5, 16, 19, 20, 22, 25, 27-35 and 37-41 are pending, of which claims 40 and 41 are withdrawn from consideration.

If claim 1 is found to be allowable, Applicants respectfully request rejoinder of withdrawn method claims 40 and 41 pursuant to MPEP §821.04(b).

Response to § 112, First Paragraph, Rejection

In paragraph 9 of the Action, claims 1, 27 and 37 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, due to claiming a “prodrug” of a compound of Formula (I).

As noted, the claims have been amended to delete the term “prodrug.” Accordingly, withdrawal of the § 112 rejection of claims 1, 27 and 37 is requested.

Response to § 112, Second Paragraph, Rejection

In paragraph 10 of the Action, claims 1, 38, and 39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Specifically, the Examiner states:

- A. R^1 represents a substituent. Can that substituent represent hydrogen?

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B. At claim 1, it is suggested that the term “group” should be added at radical, B.
C. At claim 1, penultimate line, applicant is queried for the proviso which has been added by amendment.

D. At claims 38 and 39, what chemical compounds are intended?

Applicants respond as follows.

A. At page 6, lines 23-24 of the specification and in the original claim 1, it is stated that when n is 0, R¹ represents a hydrogen atom or a substituent and that when n is 1, R¹ represents a substituent. Since n represents 1 in the current claim 1, R¹ represents a substituent which does not include a hydrogen. The substituents defined on page 23 of the specification do not include “hydrogen”. Also, one skilled in the art would not consider hydrogen as a “substituent.”

B. Claim 1 has been amended to recite that “ring B represents a dihydronaphthalene group, an indene group, or a 6,7-dihydro-5H-benzo[7]annulene group which may further have a substituent(s)”.

C. Claim 1 has been amended to recite that “when X is -O- or -CH₂-O- and ring A is phenyl, m is an integer of 1 to 5.” Further, this proviso was included in order to exclude the overlapping scope with US 2003/0139597 which was filed as an IDS on November 20, 2009.

D. Claim 38 has been amended to clarify that the claimed agent comprises the compound represented by formula (IA-2-1) according to claim 1 or a salt thereof, which has an ability to bind to EDG-6 and may have an ability to bind to EDG-1.

In view of the above, withdrawal of the § 112 rejection of claims 1, 38 and 39 is requested.

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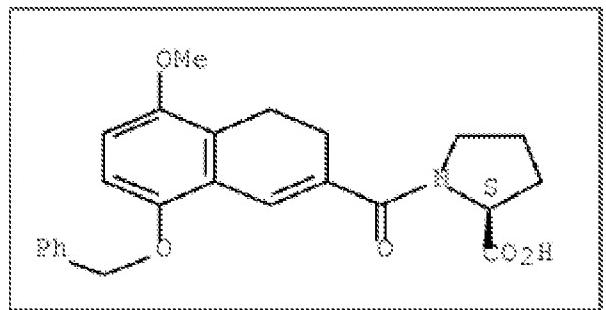
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Response to § 102(b) Rejection

In paragraph 12 of the Action, claims 1 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Warrener *et al.* (J.C.S. Chem. Comm., 1981, pp. 1100-1101, “Warrener”).

This rejection should be withdrawn because Warrener does not disclose or render obvious the present invention.

The Examiner contends that the instantly claimed compound is disclosed at page 1100, 2nd column of Warrener, see compound 8. The compound 8 is depicted below:



Compound 8 of Warrener

Per the Examiner, the claims are met when D¹ represents a nitrogen-containing heterocyclic ring, Y¹⁻³ represents methylene which has a substituent; B represents a dihydronaphthalene group; X represents -CH₂-O-; A represents a cyclic group; R¹ represents a substituent which is hydrogen; m and n represent 1.

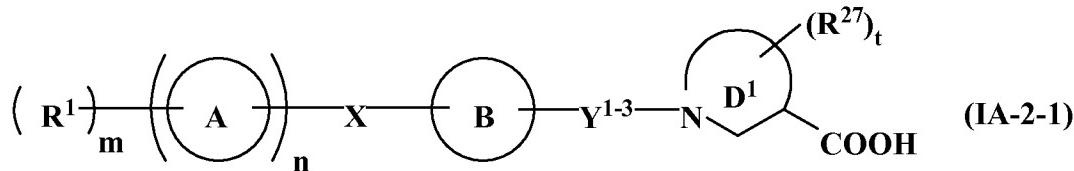
Applicants respectfully disagree.

Present claim 1 relates to a compound represented by formula (IA-2-1):

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As noted above, one skilled in the art would not consider hydrogen as a “substituent.”

Present claim 1 as amended recites that when X is -O- or -CH₂-O- and ring A is phenyl, m is an integer of 1 to 5. That is, there is at least one substituent on the phenyl ring.

However, in compound 8 of Warrener, there is no substituent on the phenyl ring.

Accordingly, compound 8 of Warrener is not included in the present claim 1 by the proviso in claim 1.

Therefore, present claims 1 and 5 are not anticipated by and are patentable over Warrener.

In view of the above, reconsideration and withdrawal of the §102 (b) rejection based on Warrener are respectfully requested.

Allowable Subject Matter

In paragraph 13 of the Action, claims 16, 19, 20, 22, 25 and 28-35 are objected to [as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form].

Applicants submit that claims 16, 19, 20, 22, 25 and 28-35 are allowable in their present form because the claims from which claims 16, 19, 20, 22, 25 and 28-35 depend are allowable, as discussed above.

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Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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